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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,264	11/12/1999	KUNIHIKO MIWA	JA9-98-171	1450

26582 7590 03/26/2003

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EXAMINER
BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/439,264	MIWA ET AL.	
	Examiner	Art Unit	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-24,27-29 and 32-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-24,27-29 and 32-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Response to Amendment

This is in response to an amendment file on February 6th, 2003. In the amendment, claims 1-20, 25, 26, 30 and 31 have been canceled, and claims 21-24, 27-29 and 32-34 remain pending in the letter.

Response to Arguments

1. Applicant's arguments with respect to claims 21-24, 27-29 and 32-34 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 21-24, 27-29 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa et al (U.S. Patent No. 6,230,268) in view of Ueda et al (U.S. Patent No. 6,289,102).

4. As per claim 21, Miwa et al teach a method of recording digital data onto a medium comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark is electronically embedded in the digital data

the digital data wherein the digital watermark is electronically embedded in the digital data through a transformation or the digital data and if the watermark is detected, then performing access control for the digital data using the watermark (*see abstract, column 2 lines 35-3 line16, 3 lines 41-55).* Miwa et al fail to teach an inventive concept of scrambling the digital data with digital watermark, and recording the scrambled digital data with digital watermark onto a medium. However, Ueda et al teach an inventive concept of scrambling the digital data with digital watermark, and recording the scrambled digital data with digital watermark onto a medium (*see abstract, column 2 lines 43-52, 3 lines 52-59).* Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive concept to include Ueda et al's of scrambling the digital data with digital watermark, and recording the scrambled digital data with digital watermark onto a medium because this would have ensured the prevention of the content recorded in the information recording medium from being illegally copied so as to realize secured copyright protection.

5. As per claim 22, Miwa et al teach a method of determining whether copying/recording of the digital data is to be stopped or continued (*column 4 lines 10-39).*

6. As per claim 23, Miwa et al teach a method further comprises embedding a copy mark into the digital data in accordance with a content of the digital watermark (*see abstract, column 2 lines 35-3 line16, 3 lines 41-55).*

7. As per claim 24,Miwa et al teach a method of recording digital data onto a medium comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark and a copy mark that is electronically embedded in the digital data through a transformation or the digital data and if the watermark is detected, then performing playback control for the descrambled digital data using the watermark and the copy mark (*see abstract, column 2 lines 35-3 line16, 3 lines 41-55).* Miwa et al fail to teach an inventive concept reading a scrambled digital data from the medium and descrambling the scrambled digital data read from the medium. However, Ueda et al teach an inventive concept of reading a scrambled digital data from the medium and descrambling the scrambled digital data read from the medium (*see abstract, column 4 lines 25-34, 53-65).* Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive concept to include Ueda et al's of reading a scrambled digital data from the medium and descrambling the scrambled digital data read from the medium because this would have ensured the prevention of the content recorded in the information recording medium from being illegally copied so as to realize secured copyright protection.

8. As per claim 27 and 32,Miwa et al teach a video driver comprising detecting from digital data any digital watermark that is electronically embedded in the digital data wherein the digital watermark and a copy mark that is electronically embedded in the digital data through a transformation or the digital data and if the watermark is detected, then performing playback control for the descrambled digital data using the watermark and the copy mark (*see abstract, column 2 lines 35-3 line16, 3 lines 41-55).* Miwa et al fail to teach an inventive for decoding a

scrambled digital data and descrambling the scrambled digital data. However, Ueda et al teach an inventive concept of for decoding a scrambled digital data and descrambling the scrambled digital data (*see abstract, column 4 lines 25-34, 53-65)*. Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Miwa et al's inventive concept to include Ueda et al's of for decoding a scrambled digital data and descrambling the scrambled digital data because this would have ensured the prevention of the content recorded in the information recording medium from being illegally copied so as to realize secured copyright protection.

9. As per claim 28, 29, 33 and 34, Miwa et al teach a video driver card wherein the scrambling digital data is an MPEG stream, and determining whether or not to output the MPEG stream and adding a copy mark to the MPEG stream (*see fig 4, column 5 lines 41-63, 6 lines 18-49)*.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892)*.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Firmin Backer
Examiner
Art Unit 3621

March 19, 2003

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600